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Paper No. 8
Entered: December 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAVIUM, INC.,
Petitioner,

v.

ALACRITECH, INC.,
Patent Owner.

Case IPR2017-01718
Patent 7,237,036 B2

Before STEPHEN C. SIU, DANIEL N. FISHMAN, and CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Cavium, Inc. ("Cavium" or "Petitioner") filed a Petition (Paper 1, "Pet.") for *inter partes* review of claims 1–7 of U.S. Patent No. 7,237,036 B2 ("the '036 patent") (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Approximately one week after filing the Petition, Petitioner filed a Motion for Joinder. Paper 3 ("Joinder Motion" or "Mot."). The Joinder Motion seeks to join Petitioner as a party to *Intel Corp. v. Alacritech*, Case IPR2017-01391 ("the 1391 IPR"). Mot. 1. The Joinder Motion indicates that Intel Corp. ("Intel"), Petitioner in the 1391 IPR, does not oppose Cavium's request to join that proceeding. *Id.* However, the Joinder Motion is silent regarding Patent Owner's position regarding the Joinder Motion.

Alacritech, Inc. ("Patent Owner") did not file an Opposition to the Joinder Motion. Moreover, Patent Owner filed a Preliminary Response that is silent regarding the Joinder Motion. Paper 7 ("Prelim. Resp.").

As explained further below, we institute trial in this *inter partes* review on the same ground as instituted in IPR2017-01391, and we grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Institution of Trial

In IPR2017-01391, Petitioner Intel challenges the patentability of claims 1–7 of the '036 patent on the following ground:

References	**Basis**	**Claims challenged**
Erickson[1] and Tanenbaum[2]	§ 103	1–7

[1] U.S. Patent No. 5,768,618, issued June 16, 1998 ("Erickson," Ex. 1005).
[2] Andrew S. Tanenbaum, *Computer Networks* (3d ed. 1996) ("Tanenbaum," Ex. 1006).

IPR2017-01391, Paper 2, 14–15.

After considering the Petition and the Patent Owner's Preliminary Response in IPR2017-01391, we instituted trial for claims 1–7 based on the above-identified ground of unpatentability. *See* IPR2017-01391, Paper 8, 3, 18. Petitioner here (Cavium) represents that the instant Petition is substantively identical to the Petition in IPR2017-01391 and challenges the same claims based on the same ground. Mot. 1. We have considered the relevant Petitions, and we agree with Petitioner's representation that the instant Petition is substantially identical to the Petition in IPR2017-01391. *Compare* Pet., *with* IPR2017-01391, Paper 2.

Patent Owner's Preliminary Response does not point out any differences from its Preliminary Response in the 1391 IPR. However, after reviewing Patent Owner's Preliminary Responses here and in the 1391 IPR, we find the two responses to be substantially identical, with one exception. We note that, here, Patent Owner argues that QLogic, Inc. ("QLogic") should have been named as a real party in interest because QLogic, a wholly owned subsidiary of Cavium, is a supplier to, and indemnitor of, Dell (the defendant in related infringement litigation), and that Cavium's only interest in the '036 patent is that of its subsidiary QLogic. *See* Prelim. Resp. 13–20. In the 1391 IPR, Patent Owner presented a similar argument in its Preliminary Response that Petitioner Intel should have named Cavium and Dell as real parties in interest because of the alleged supplier-indemnitor relationship between Intel and Dell and Cavium and Dell. IPR2017-01391, Paper 7. Here, Patent Owner argues the parent/subsidiary relationship between Petitioner and QLogic and the supplier/indemnitor relationship

between QLogic and Dell require that QLogic be named as a real party in interest. *See* Prelim. Resp. 13–20.

We have reviewed Patent Owner's arguments. On the record before us and for purposes of this Decision, and for the similar reasons as in the 1391 IPR, we determine there is insufficient evidence that QLogic controlled, or had the opportunity to control, this Petition and, thus, is not a real party in interest. *See* Case IPR2017-01391, Paper 8, 3–6. Moreover, as in the 1391 IPR, there is no allegation that naming additional real parties in interest such as QLogic or Dell would bar Petitioner in the instant proceeding. *See id.* at 5. Accordingly, the issue Patent Owner raises is not jurisdictional. *See Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 6 (PTAB March 4, 2016) (Paper 38) (precedential).

Accordingly, for essentially the same reasons stated in our Decision to Institute in IPR2017-01391, we conclude Petitioner has established a reasonable likelihood of prevailing with respect to at least one challenged claim, and we institute trial in this proceeding for claims 1–7 on the same ground as in IPR2017-01391.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner for *inter partes* review to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that "[i]f the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311." *Id.*

Without opposition to the Joinder Motion from any party, we grant Petitioner's Motion for Joinder with the 1391 IPR, subject to the condition that Cavium will be bound by all substantive and procedural filings and representations of Intel in the 1391 IPR, without a separate opportunity to be heard, whether orally or in writing, unless and until the proceeding is terminated with respect to Intel.

In view of the foregoing, we determine that joinder based upon the above-noted condition will have little or no impact on the timing, cost, or presentation of the trial on the instituted ground. Moreover, discovery and briefing will be simplified if Cavium is joined as a party to the 1391 IPR.

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted for claims 1–7 of the '036 patent under 35 U.S.C. § 103(a) over and Erickson and Tanenbaum;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2017-01391 is *granted*, and Cavium, Inc. is joined as a petitioner in IPR2017-01391;

FURTHER ORDERED that the ground on which an *inter partes* review was instituted in Case IPR2017-01391 remains unchanged, and no other grounds are instituted in the joined proceedings;

FURTHER ORDERED that Petitioner here (i.e., Cavium, Inc.) will be bound in IPR2017-01391 by all substantive and procedural filings and representations of current Petitioner in IPR2017-01391 (i.e., Intel Corp.),

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